

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Chang et al. Docket: YOR920010287US1 (8728-514)
Serial No.: 09/925,397 Group Art Unit: 2162
Filed: August 9, 2001 Examiner: Ehichioya, Fred I.
For: **METHOD FOR INDICATING CONSUMER DEMAND**

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Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner:

In response to the Advisory Action dated October 23, 2008, Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal and a Pre-Appeal Brief Request For Review Form (PTO/SB/33).

REMARKS

Claims 20-24, 26-31, and 33 are pending. The Examiner's reconsideration of the rejections is respectfully requested in view of the remarks.

Claims 20-24, 26-31 and 33 have been rejected under 35 U.S.C. 102(e) as being unpatentable over Vitter (*Constrained Querying of Multimedia Databases: Issues and Approaches*). The Examiner stated essentially that Vitter teaches all the limitations of Claims 20-24, 26-31 and 33.

The Vitter reference is describing applicant's own work. A affidavit under 37 CFR 1.132 was previously filed to remove the Vitter reference. By the Advisory Action, the Examiner suggested that the affidavit is insufficient as failing to explain exactly how the declarations therein were reached or what facts were relied upon; specifically the Examiner stated that “affidavits must establish facts (MPEP 716.01(c)) and an opinion presenting a legal conclusion is not entitle to any weight (MPEP 716.01(c)(III)).”

MPEP 716.01(c) concerns objective evidence. Under the facts of the present application objective evidence is not required; MPEP 716.01(c) is not applicable under the facts of the application. Consider that MPEP 715.01(c) applies under the facts set forth in the affidavit. MPEP 715.01(c) states that “where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction”

is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).” MPEP 715.01(c) provides that in cases of co-authorship of a publication a mere indication by the applicant of the limited nature of co-author’s contribution is sufficient to remove the publication. MPEP 716.10 is probative here, stating explicitly that “an uncontradicted ‘unequivocal statement’ from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. In re DeBaun, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982).” The affidavit filed September 26, 2008 unequivocally sets forth the inventorship and declares that Jeffrey S. Vitter’s role in the publication was limited to that of a faculty advisor. Applicants note that faculty advisors are typically listed as co-authors in student’s work. Furthermore, the publication itself at page 1 clearly indicates that “this work was done while the author (Apostol (Paul) Natsev) was visiting IBM T.J. Watson Research Center”; Jeffrey S. Vitter being a faculty advisor at Duke University. In view of both MPEP 715.01(c) and 716.10 the affidavit previously filed is believed to be sufficient.

Accordingly, there is believed to be clear error in the application of MPEP 716.01(c) in maintaining the rejection. Reconsideration of the rejection is respectfully requested.

For the forgoing reasons, the application, including Claims 20-24, 26-31, and 33 is believed to be in condition for allowance. Early and favorable reconsideration of the case is respectfully requested.

Respectfully submitted,

Dated: November 3, 2008

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